

Applicant respectfully disagrees with the examiner's analysis. MPEP 806.05(a) defines a combination as an organization of which a subcombination or element is a part. The alleged subcombination of claims 12 and 14-19 (a key blank) is not an element or part of the combination that comprises a lock and key. With respect to Group I and Group II, the examiner's argument in support of the requirement for restriction does not address the first requirement of distinctness with respect to claims 12, 18 and 19. If claim 12 is directed to the same invention as Group I, then the requirement for restriction must fail with respect to Groups I and II.

The examiner's argument does not address the first requirement of distinctness with respect to any of the claims of Group III.

The basis for the requirement for restriction between Group II and Group III is stated as being that these are subcombinations disclosed as usable together in a single combination. Applicant respectfully disagrees. The examiner has not pointed out a combination in which a key and a key blank may be used together. MPEP 806.05(d) is applicable, for example, to the case of a transmitter and a receiver or a lock mechanism and a key, and a requirement for restriction can be maintained when one of the subcombinations, e.g. the transmitter, has utility other than in the disclosed combination. Conversely, if the transmitter and receiver only have utility in combination with each other, e.g. because the transmitter claim defines a modulation function and the receiver claim defines the inverse modulation function, such that the claimed receiver must be used in order to detect the information transmitted by the claimed transmitter, the transmitter and receiver are not distinct and a requirement for restriction should not be made. In the absence of an appropriate basis for concluding that Groups II and III are distinct, the requirement for restriction must be withdrawn as between those groups of claims.

Claims 1-11, 30 and 31 stand rejected under 35 USC 112, second paragraph, as being indefinite, based on the phrase "clears the first counter surface" in claims 1 and 31.

Applicant respectfully submits that the language concerning clearing the first counter surface is clear. The examiner suggests that this language could mean either that the combination surface rotates past the first counter surface of the second disc or the

combination surface does not reach the first counter surface of the second disc. The examiner has not cited any authority to support the latter interpretation and applicant submits that the latter interpretation is not consistent with the normal idiomatic use of the verb "clear" in the sense that it is contemplated. The appropriate definition for the verb "clear" in Webster's Third New International Dictionary of the English Language is "to go over or by without touching, colliding, or getting entangled." A commentator at a track meet who announces that an athlete cleared the hurdle certainly does not conjure up the vision of the athlete coming to a stop before reaching the hurdle. Applicant believes that there is no reasonable definition of the verb "clear" that supports the examiner's rejection under 35 USC 112, second paragraph.

Claims 1-9, 30 and 31 stand rejected under 35 USC 102 over Taylor and claims 1-3, 5-7, 10, 30 and 31 stand rejected under 35 USC 102 over FI '618. Applicant respectfully traverses. The discussion of lost motion in columns 5 and 6 of Taylor does not disclose operation in accordance with the last paragraph of claim 1. Claim 1 recites that upon turning the key through a first turning angle in the first turning direction, the combination surface corresponding to the first code locking disc engages the first counter surface bounding the key opening of the first code locking disc and the combination surface corresponding to the second code locking disc clears the first counter surface bounding the key opening of the second code locking disc. Claim 1 requires, in essence, that the combination surface corresponding to the second code locking disc should lead the combination surface corresponding to the first code locking disc when the key is turned in the first turning direction. Suppose, for example, that the key of Taylor included a first bit contoured to engage the pickup step 76 of a first tumbler and a second bit contoured to engage the pickup step 77 of a second tumbler. On inserting the key in the lock and turning the key in the clockwise direction as seen in FIG. 6, the first bit engages the pickup step 76 of the first tumbler and subsequently the second bit engages the pickup step 77 of the second tumbler. However, during the turning movement to the angle at which the first bit engages the pickup step 76 of the first tumbler, the second bit does not clear the pickup step

76 of the second tumbler as would be required in order to meet claim 1.

The disclosure of FI '618 relative to the interaction between the key shown in FIG. 11 and the locking disc shown in FIG. 10 is essentially the same as that of Taylor. When the key is inserted in the lock and turned in the clockwise direction, a longer bit engages a radially outward counter surface 17 of a first locking disc whereas a shorter bit engages a radially inward counter surface 18 of a second locking disc and does not engage the radially outward counter surface of the second locking disc. However, during the turning movement to the angular position at which the longer bit engages the counter surface 17 of the first locking disc, the shorter bit does not clear the counter surface 17 of the second code locking disc as would be required in order to meet claim 1. On the contrary, the shorter bit only clears the first counter surface of the second locking disc upon turning of the key through a further turning angle in the clockwise direction.

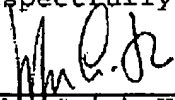
In view of the foregoing, it is submitted that claim 1 is not anticipated by either Taylor or FI '618. It follows that the dependent claims also are not anticipated.

Claim 31, like claim 1, requires that upon turning the key through a first turning angle in the first turning direction, the combination surface corresponding to the first code locking disc engages the first counter surface bounding the key opening of the first code locking disc and the combination surface corresponding to the second code locking disc clears the first counter surface bounding the key opening of the second code locking disc. This feature is not disclosed or suggested by Taylor or FI '618. Therefore, for similar reasons to those discussed above in connection with claim 1, applicant submits that claim 31 is not anticipated by Taylor or FI '618.

Claim 9, which is directed to the feature shown in FIG. 7, stands rejected under 35 USC 102 over Taylor. Claim 9 recites that the return surface (the surface 4a' in FIG. 7) is aligned with one of the counter surfaces of the first locking disc. It will be seen in FIG. 7 that the two surfaces 4a' are aligned with the counter surfaces 4a12 and 4a32 respectively. This feature is not shown by Taylor, in which

the return surface 73 (FIG. 6) is not aligned with any of the pickup steps 75-78.

Respectfully submitted,



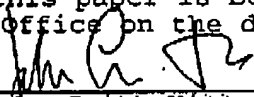
John Smith-Hill
Reg. No. 27,730

SMITH-HILL & BEDELL, P.C.
12670 NW Barnes Road, Suite 104
Portland, Oregon 97229

Tel. (503) 574-3100
Fax (503) 574-3197
Docket: AWEK 1912

Certificate of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.



John Smith-Hill

2/28/03

Date